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In re Application of:
TAYLOR, Stephen, Maxwell, et al.
U.S. Application No.: 10/510,614
PCT No.: PCT/AU03/00415
International Filing Date: 07 April 2003
Priority Date: 08 April 2002
Atty's Docket No.: 36677.30 (4050.003000)
For: USE OF C5A RECEPTOR
ANTAGONIST IN THE TREATMENT
OF FIBROSIS

DECISION ON RENEWED
REQUEST UNDER
37 CFR 1.497(d) AND PETITION
UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Renewed Petition Under 37 CFR 1.47(a) and 37 CFR 1.497(d)" filed 05 May 2006.

BACKGROUND

The procedural background for the present application was set forth in the decision mailed herein on 08 March 2006. In that decision, applicants' request to add Michael WHITEHOUSE as an inventor herein was dismissed for failure to comply with the requirements of 37 CFR 1.497(d). The decision also dismissed as moot applicants' petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of Mr. WHITEHOUSE, whom applicants asserted had refused to sign the application.¹

On 05 May 2006, applicants filed the "Renewed Petition Under 37 CFR 1.47(a) and 37 CFR 1.497(d)" considered herein.

37 CFR 1.47(a) asserts that Mr. WHITEHOUSE has refused to execute the declaration.

DISCUSSION

1. Renewed Request Under 37 CFR 1.497(d):

The renewed petition includes a statement from the person being added as an inventor (Michael WHITEHOUSE) confirming that the error in inventorship in the international

¹ The petition was considered moot because Mr. WHITEHOUSE was not an inventor of record herein.

application occurred without deceptive intent. This statement satisfies the requirement of 37 CFR 1.497(d)(1).

The renewed petition also includes the consent of the assignee to the change in inventorship.

These materials satisfy the outstanding requirements for a grantable request under 37 CFR 1.497(d). Michael WHITEHOUSE is therefore properly added as an inventor of record herein.

2. Renewed Petition Under 37 CFR 1.47(a):

On 14 October 2005, applicants filed a petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of Michael WHITEHOUSE, whom applicants asserted had refused to sign the declaration.

The petition under 37 CFR 1.47(a) was dismissed as moot because Mr. WHITEHOUSE was not an applicant of record herein.

Now that Mr. WHITEHOUSE has been added as an inventor of record, the petition under 37 CFR 1.47(a) may be properly considered.

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have filed the required petition fee, and the petition expressly states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have filed a declaration executed by three of the four inventors and containing an unsigned signature block for the non-signing inventor, Michael WHITEHOUSE. This declaration may be accepted as having been executed by the inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning

inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants provided statements of facts from Vivien Bedford Santer and Alan Robert Scott, with supporting documents, as evidence that Mr. WHITEHOUSE had refused to execute the declaration. However, neither statement provides the required firsthand statement confirming the mailing of the complete application to the non-signing inventor.² Applicants have included a copy of a letter from Mr. WHITEHOUSE to Mr. Scott, in which he refuses to execute an assignment, but this letter does not refer to the declaration. Ms. Santer states that she spoke to Mr. WHITEHOUSE and that he "again refused to execute the declaration." However, it is not clear whether this is a reference to the assignment or the declaration (the "again refused" phrase is directed to the letter in which the inventor refused to sign the assignment). Moreover, after the time period referenced in the statements of Mr. Scott and Ms. Santer, the inventor agreed to execute the statement required under 37 CFR 1.497(d) (filed herewith). In light of the inventor's cooperation with respect to signing such statement, applicants must provide some clarification as to whether the inventor is still refusing to execute the inventor's declaration.

Before item (4) can be considered satisfied, applicants must provide the required firsthand evidence (with documentary support) demonstrating that the complete application papers and a request for signature on the inventor's declaration have been delivered to the non-signing inventor at his last known address, and that the inventor has refused to execute the declaration. Such a showing should make clear that the inventor's refusal continues even though after his agreement to sign the statement under 37 CFR 1.497(d).

CONCLUSION

Applicants' renewed request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**. Accordingly, Michael WHITEHOUSE is hereby added to the present application as an inventor of record.

The petition under 37 CFR 1.47(a) seeking acceptance of the declaration without the signature of Michael WHITEHOUSE is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)"

² Mr. Scott states that a copy of the declaration was forwarded to Mr. WHITEHOUSE, but it is not made clear whether a copy of the complete application was included with this mailing, nor is it made clear that Mr. Scott has the required firsthand knowledge regarding this mailing.

and must include the materials required to satisfy item (4) of a grantable petition, as discussed above (i.e., an acceptable showing that the non-signing inventor refuses to execute the declaration).

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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